

Amendment

Applicant:

Serial No.: 09/865,893

Filed: May 25, 2001

Docket No.: T634.112.101

Title: CO-BRANDED INTERNET SERVICE PROVIDER AND RETAILER INTERNET SERVICE SITE WITH RETAILER-OFFERED INCENTIVES FOR MEMBER USE

REMARKS

Attention is directed to the attached Change of Correspondence Address.

Claims 1-29 are pending. By this Amendment, claims 1, 4, 6-8, 10, 13-17 and 21-22 are amended, and new claims 27-29 are added.

The Office Action rejected claims 1-5 and 11-24 under 35 U.S.C. § 102(e) over Tobin (U.S. Patent No. 6,141,666) and claims 6-12 and 25-26 under 35 U.S.C. § 103(a) over Tobin in view of Official Notice. Applicants respectfully traverses these rejections.

Independent claim 1 combines the features of original dependent claim 8 and original independent claim 1. Applicant traverses the examiner's assertion of Official Notice with respect to the features of original dependent claims 8-9. The record provides no evidence that providing members with a discount on subscription fees for access to the recited co-branded Internet site, based upon a quantity of merchandise purchased from the recited retailer, would have been obvious. Note claim 1, last three lines, as well as amended dependent claim 8 and original dependent claim 9. The undersigned is unaware of any art with an early enough date to render the claimed features obvious, and respectfully requests that the Patent Office provide authority or evidence to support the statement of Official Notice.

Independent claim 25 recites distributing at retailer locations client software for accessing a co-branded Internet site, the co-branded Internet site including one or more links to an Internet shopping site of the retailer. Note claim 25, lines 6-8. Also note independent claim 26, lines 5-8, and dependent claim 10. Applicant traverses the examiner's assertion of Official Notice with respect to the features of original independent claims 10 and 25-26. The record provides no

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evidence that distributing at retailer locations client software for accessing a co-branded Internet site, the co-branded Internet site including one or more links to an Internet shopping site of the retailer, would have been obvious. The undersigned is unaware of any art with an early enough date to render the claimed features obvious, and respectfully requests that the Patent Office provide authority or evidence to support the statement of Official Notice.

Applicant traverses the examiner's assertion of Official Notice with respect to the features of original dependent claims 6-7 and 11-12. The record provides no evidence that providing the recited members with access to advertising circular content through the co-branded Internet site before corresponding printed advertising circulars are distributed (claim 6), providing members with the recited notices through the co-branded Internet site before publishing notices to non-members (claim 7), distributing software for the co-branded Internet site on the Internet shopping site (claim 11), or distributing software for the co-branded Internet service site on the Internet service site of the Internet service provider (claim 12), would have been obvious. The undersigned is unaware of any art with an early enough date to render the claimed features obvious, and respectfully requests that the Patent Office provide authority or evidence to support the statement of Official Notice.

New dependent claim 27 depends from claim 5 and recites that a rate of a discount on merchandise purchased on the Internet shopping site accessed through the co-branded Internet site varies on the basis of the length of a member's subscription to the Internet service provider. New dependent claim 28 depends from claim 25 and recites that the Internet service provider offers a news channel featuring news stories of interest to a demographic group of members, the

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method comprising providing to members a link to a news article and a link to a page on the Internet shopping site offering for sale a product featured in the news article. None of the prior art teaches or suggests these features. The other dependent claims recite additional features, not taught or suggested by the prior art.

New independent claim 29 is original dependent claim 21 rewritten in independent form, reciting a link to an application for a proprietary credit card issued by the retailer. Original dependent claim 21 was rejected only under 35 U.S.C. § 102(e) over Tobin. Nothing within the four corners of Tobin, however, discloses a link to an application for a proprietary credit card issued by a retailer. Applicant submits that the 35 U.S.C. § 102(e) rejection over Tobin is improper and notes that any new ground of rejection applied against independent claim 29 would not be necessitated by this Amendment.

The amendments to claims 4, 6-7, 10, 13-17, and 21-22 are for clarity and/or to better satisfy 35 U.S.C. § 112, second paragraph and not for purposes of overcoming the prior art.

Conclusion

In view of the foregoing, Applicant submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance are requested. The Commissioner is hereby authorized to grant any extensions of time and to charge any fees that may be required during the entire pendency of this application, or to credit any overpayment, to Deposit Account No. 500471.

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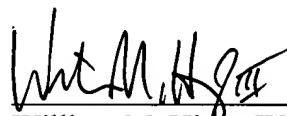
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The Examiner is invited to telephone the undersigned to advance prosecution.

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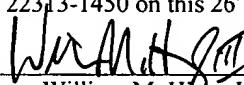
Respectfully submitted,


William M. Hienz III
Reg. No. 37,069

Please grant any extension of time necessary for entry; charge any fee due to Deposit Account No. 500471.

CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail with sufficient postage, in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 26th day of August, 2004.

By 
Name: William M. Hienz III